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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/574,682	04/04/2006	Ulrich Bohne	3623	2210

7590  
Striker, Striker & Stenby  
103 East Neck Road  
Huntington, NY 11743

05/22/2009

EXAMINER
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MORGAN, EILEEN P

ART UNIT	PAPER NUMBER
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3723

MAIL DATE	DELIVERY MODE
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05/22/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/574,682	BOHNE ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Eileen P. Morgan	3723	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 13 May 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-5,9 and 11-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5,9,11-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 16 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 16 is totally unclear. It is unclear what two 'regions' of the conduit with 'longitudinal lengths' are being claimed. What part of conduit surrounds motor? The conduit does not surround motor. The two lengths and regions are unclear.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 9, 11-21 rejected under 35 U.S.C. 102(b) as being clearly anticipated by Izumisawa-5,919,085.

Izumisawa discloses a hand-held power sander comprising a housing (1,35), motor for driving a shaft (25), a suction conduit (42) within housing and having a chamber portion (41) surrounding and adjoining spindle (25) and acting as an intake at a face of the housing, the suction conduit extending along underside of motor

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(11,12,13), past a bearing flange (38), to an outlet stub (end where 42 joins 43), a tool receptacle (28) having a suction opening (30) directly coupled to conduit (42) via a region that is open toward outside of tool (47) to form an annular gap between housing and tool receptacle.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4,5,22 rejected under 35 U.S.C. 103(a) as being unpatentable over Izumisawa, alone.

Izumisawa discloses a hand-held power sander as detailed above, but does not disclose inner radial region of conduit to be less than 1 cm nor the gap size. However, both of these limitations, the inner radial distance and the gap size, would have been obvious design expedients and within the level of one of ordinary skill in the art.

### ***Response to Arguments***

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Applicant states that Izumisawa teaches an upper and lower housing and that lower housing 35 does not surround motor. However, Examiner interprets parts 1 and

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35 to constitute housing and Applicant's sander is similar in that there is an upper and lower housing divided by the upper 'wall' of conduit 18 and spindle passes through the upper wall similar to Izumisawa. Therefore, the housing parts 1 and 35 constitute the housing and read on the claimed limitations. Applicant asserts that exhaust 42 is only for air passing through 9 and out of 16. Exhaust conduit 42 indeed is a suction conduit for exhausting air/debris from 30 into 41 and out of 42 into 43. Conduit 42 is 'under' motor as detailed above and satisfies claimed limitations. It is not understood how Applicant insists that conduit 42 which includes outlet end and chamber (41) located in front end is 'not part of housing (1,35, which shown in drawings is in lower part 35) and is not in intake.' The drawings clearly show the path of air/debris come into 30 flow into 41 and out of 42 into 43 (col. 4, lines 58-67, col.6, lines 5-20). Clearly 42 in connection with 41 acts as an intake. Element 30 clearly acts a conduit for air/debris (col. 6, lines 5-20). Izumisawa is indeed a 102 reference properly applied and referenced to meet claimed limitations.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eileen P. Morgan whose telephone number is 571.272.4488. The examiner can normally be reached on Monday-Thursday, 7am-3:30pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Hail can be reached on 571.272.4485. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

EM

May 16, 2009

/Eileen P Morgan/

Primary Examiner, Art Unit 3723